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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,605	01/25/2001	Glenn Ricart	300/2	4396
27538	7590	06/28/2006	EXAMINER	
KAPLAN GILMAN GIBSON & DERNIER L.L.P. 900 ROUTE 9 NORTH WOODBRIDGE, NJ 07095			HANNE, SARA M	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/769,605	RICART ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sara M. Hanne	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 7-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5 and 7-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This action is responsive to the amendment received on April 5, 2006. Claims 1-5 and 7-15 are pending in the application. Claims 6 and 16 were cancelled in the claims filed November 3, 2003.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 12 recite the phrase "in a durable way". The term "durable" is meant to describe something with tangible strength or capability to withstand wear or decay. What is durable about information?

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by East et al., U.S. Patent Publication No. 2003/0061323.

In accordance with Claim 1, East et al. discloses sending a generic server personalization information for personalizing the server, storing the personalization information on the server in a durable way ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39) and sending the server personalization information for personalizing a client of the server ("remote/master administrative server 202B controls updates for thin clients 200C-D and remote administrative server", Pg. 4, Par. 50) and storing the information for personalizing the client on the client in a durable way ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39).

Claim 2 teaches that the information sent must be at least one of "the server's name, the domain in which it resides . . ." etc. taught by East et al. by configuring the network ("changing TCP/IP configurations", Pg. 5, Par. 54).

Claim 3 also teaches that the information sent can be Windows operating system registry information. East et al. teaches this limitation by installing a new device ("an operating system update, the addition of a new device driver, a change in device settings", Pg. 4, Par. 50). Also, the background art in this patent application does refer to prior art listed on novell.com in the form of software that can collect the Desktop

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policies and profiles, which would include registry information and corporate policy information.

As in Claim 7, East et al. further discloses the server to receive and durably store (“a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.”, Par. 39) the personalization information for the Server and for the Client, the server personalizing itself according to this information, sending the Client its information, and the Client personalizing itself based on the information it receives (“Remote/master administrative server 202B then conveys the update to remote server 202C and thin clients 200C-D. Remote server 202C then conveys the update to thin clients 202E-N.”, Pg. 5, Par. 50) and to durably store the client personalization information (“a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.”, Par. 39).

As in Claim 4, East et al. teaches personalizing the server after the client has been personalized as seen in the rejection of Claim 7 *supra*. Therefore the system ignores workstation requests for personalization until the server is personalized.

As in Claim 8, East et al. teaches the client to be a laptop disconnectable from the server (“LAN 104 may include a number of interconnected computer systems and optionally one or more other devices: for example, one or more workstations 110a, one or more personal computers 112a, one or more laptop or notebook computer systems 114, one or more server computer systems 116, and one or more network printers 118.”, Pg. 3, Par. 36).

As in Claim 9, East et al. teaches a higher-tier server that receives personalization information for the client's server and provides this information back to the server after the server receives and durably stores ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39) it and at least partially personalizes itself using this information ("an administrative server is a computer that controls updates and configurations for one or more other administrative servers and/or one or more thin clients", Pg. 4, Par. 50).

### ***Claim Rejections - 35 USC § 103***

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 5 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over East et al., U.S. Patent Publication No. 2003/0061323.

As in Claim 5, East et al. teaches personalizing the client as seen in the rejection of Claim 7 *supra*. East et al. fails to teach ignoring user requests until the client is at least partially personalized as recited in the claims. It would be obvious to one of ordinary skill in the art to ignore user requests temporarily until the client has been personalized at least partially. One would have been motivated to make such a combination because a personalization method that is executed long enough so that it may complete the request of the user would have been obtained.

As in Claims 10 and 11, East et al. teaches transmission of Roles and Workstation information as further described in Claim 7 of the application seen *supra*. East et al. fails to teach one piece of information to be dominate or submissive to another. It would be obvious to one of ordinary skill in the art to make a specific piece of information, roles workstation or user information, dominate or submissive. One would have been motivated to make such a combination because a personalization method for controlling the order in which the information is processed would have been obtained.

As in Claim 12, East et al. teaches collecting and storing server and client personalization information pertaining to the existing server and client, sending the personalization information to a new server (Copy Configuration, Pg. 5, Par. 56-58) to personalize the server with the other server's information, storing the personalization information by the server in a durable way ("a non-volatile memory such as a magnetic

media, e.g., a hard drive, or optical storage.", Par. 39, sending the personalization information for the Client to a new client to personalize the client with the other client's information ("plug-and-play customization for new clients.", Pg. 6, Par. 60) and storing the personalization information that pertains to the client in a durable way ("a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage.", Par. 39). East et al. fails to teach the new client/server to be replacements for the old client/server. It would be obvious to one of ordinary skill in the art to remove the old client/server and replace them with the new ones that have a copy of the old client/server's personalization information. One would have been motivated to make such a combination because a personalization method that can remove old hardware would have been obtained.

Further in reference to Claim 13, East et al. teaches the personalization information to be stored with a remote service provider (Remote/master administrative server 202B).

In reference to Claim 14, East et al. teaches the personalization information to include roles information (Figure 8 clusters, and MAC address), net information ("network management information can be transferred", Pg. 8, Par. 90), client information (Claim 7 rejection *supra*) and user information ("change in device settings", Pg. 4, Par. 50).

In reference to Claim 15, East et al. teaches the role information comprising personalization information common to or driven by roles or functions within a company. They further teach the net information comprising personalization information common

to a workgroup, network, or server, along with client information comprising personalization information specific to the client and user information comprising information specific to a user (see Claim 14 rejection, *supra*).

***Response to Amendment***

Applicant's arguments filed 4/5/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "survives re-booting the client or server" and "relogging into a server by a client or subserver", page 2 of arguments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show durable storage or personalization information, the examiner disagrees. The section recited by the applicant that the applicant claims to be teaching away from the storage or information on page 8 of the submitted remarks, refers to the Background section of East et al. and not the actual disclosure of the invention. Furthermore, East et al. teaches a memory medium including "a non-volatile memory such as a magnetic media, e.g., a hard drive, or optical storage." (Par. 39) which qualifies as more than just RAM.

Just because a client is a thin client does not mean that it fails to store anything permanently. There is limited storage, but there are degrees of thinness of a thin client.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

A handwritten signature consisting of a stylized 'H' and 'A' followed by the name 'BA HUYNH' and 'PRIMARY EXAMINER' written below it.